The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL KWAN
and ERIC LIU

Appeal No. 2005-0003
Application 09/920,891

ON BRIEF

Before WARREN, WALTZ and DELMENDO, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

Appealed claims 17 through 22, all of the claims in the application, stand rejected solely under 35 U.S.C. § 103(a) as being unpatentable over Hong et al. (Hong) in view of Papasouliotis et al. (Papasouliotis) (answer, pages 3-5). The ground of rejection has embedded therein United States Patent No. 5,937,323 to Orczyk et al. (Orczyk), issued August 10, 1999, which is not listed in the statement of the rejection or in the listing of "Prior Art of Record" (answer, page 3, and page 4, last line). The examiner relies on Orczyk to show that "the deposition step is

typically done at a higher temperature" because neither Hong nor Papasouliotis disclose the step of "thereafter, cooling the substrate" specified in claim 17, or the instructions in a program "to control the gas-delivery system thereafter to flow a heat-transferable gas to cool the substrate" specified in claim 20, and in these respects, Orczyk is specifically relied on to support the examiner's conclusion that it would have been obvious to lower the temperature of the substrate after the deposition step and before the etch step (answer, sentence bridging pages 4-5).

Further, the examiner lists Kholodenko et al. (Kholodenko) and Sherstinsky et al. (Sherstinsky) in the listing of "Prior Art of Record" (answer, page 3), and relies on the teachings of these references in response to appellants' arguments, for the proposition that the etching step may need cooling (answer, pages 6-7).

A review of the Office actions, including the answer, in this application shows that the examiner has supplemented the evidence in these respects apparently missing from Hong and Papasouliotis and necessary to the ground of rejection with the teachings of Orczyk, Kholodenko and Sherstinsky.

Appellants correctly point out that while Kholodenko and Sherstinsky have been discussed in the brief and the answer, these references are not part of the ground of rejection advanced on appeal. We note that neither the examiner nor appellants discusses Orczyk.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to either (1) specifically withdraw the arguments based on Orczyk, Kholodenko and Sherstinsky and rely solely on Hong and Papasouliotis, or (2) entirely restate the ground of rejection properly incorporating Orczyk, Kholodenko and Sherstinsky with Hong and Papasouliotis and provide a full explanation of the relevance of each in the context of the other references, taking into consideration the arguments raised with respect to Kholodenko and Sherstinsky in the brief and reply brief, with a view toward placing this application in condition for decision on appeal with respect to the issues presented. Reliance on a reference to support a ground of rejection that is not included in the statement of the rejection is clearly impermissible. *See In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n.3 (CCPA 1970); *cf. Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental answer's answer exercise one of" the two options set forth in 37 CFR §1.41.50(a)(2) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).

Remanded

CHARLES F. WARREN)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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ROMULO H. DELMENDO)
Administrative Patent Judge)

Applied Materials, Inc.
2881 Scott Blvd. M/S 2061
Santa Clara, CA 95050